

Engelhardt et al.

Serial No.: 10/717,140

Filed: November 18, 2003

Page 3 [Reply To The Species Election Under 37 C.F.R. §1.146

(As Set Forth In The June 9, 2010 Office Communication) – July 22, 2010]

REMARKS

No claims have been amended, added or canceled by this paper which is a reply to the Species Election under 37 C.F.R. §1.146 as set forth in the June 9, 2010 Office Communication. Claims 91, 93-102, 104, 110-119 and 122-129 are presently pending in this application.

Election of Species

According to the June 9, 2010 Office Communication (page 2):

In view of newly added claims 124-129, the examiner notes that this application contains claims directed to the following patentably distinct species:

- (1) said promoter is an eukaryotic promoter (claims 124, 126, and 128)
- (2) said promoter is a bacteriophage promoter (claims 124, 126, and 128).

The Office Communication continues on pages 3-4):

This application further contains claims directed to the following patentably distinct species:

- (3) said polymerase is an eukaryotic RNA polymerase (claims 125, 127, and 129)
- (4) said polymerase is a bacteriophage RNA polymerase (claims 125, 127, and 129)

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, generic claims are claims 91, 93-102, 104, 110-119, 122-124, 126, and 128.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search

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queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

...

The requirement for species election is respectfully traversed.

At the outset, Applicants respectfully submit that the various members recited in previously added claims 124-129 clearly represent a reasonable number of species (only two!) which are permitted under U.S. patent law. Examination of both members represented by the conjugates of claims 124-129 will not impose a harsh or undue burden on either the search for prior art or in the examination of this application in light of any prior art that may be uncovered.

Applicants believe that many of the above-named species are recited in the same claim or claims of issued U.S. patents. See, for example, Polo et al., U.S. Patent No. 6,242,259 (claim 53 "wherein said promoter is a eukaryotic promoter;" and claim 54 "wherein said promoter is a bacteriophage promoter"); and Polo et al., U.S. Patent No. 6,329,201 (claim 7 "wherein said promoter is a eukaryotic promoter;" and claim 8 "wherein said promoter is a bacteriophage promoter")

To be responsive, however, Applicants hereby elect the species bacteriophage promoter and bacteriophage polymerase. Each of claims 124-129 encompass the elected invention.

Before closing, Applicants believe that one or more of the currently named inventors continue to be an inventor of at least one claim in the pending claims, including claims 124-129 which are the subject of this species election. No amendment of inventorship is believed, therefore, to be required or necessary.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the requirement for election of species. Examination of all the claims, 91, 93-102, 104, 110-119 and 122-129, is respectfully urged and believed to be in order.

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Early and favorable action is respectfully requested.

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SUMMARY AND CONCLUSIONS

This is responsive to the requirement for species election under 37 C.F.R. §1.146 as set forth in the June 9, 2010 Office Communication. No claim amendments have been made by this paper.

This paper is accompanied by Applicants' Request For Extension Of Time (1 Month) and authorization for the fee therefor. No other fee or fees are believed due in connection with this filing. In the event that any such other fee(s) is/are due, however, The Patent and Trademark Office is hereby authorized to charge the amount of any such fee(s) to Deposit Account No. 05-1135, or to credit any overpayment thereto.

Applicants respectfully request early examination of all of the pending claims, 91, 93-102, 104, 110-119 and 122-129.

Early action to that end is respectfully requested.

Respectfully submitted,



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